

REMARKS

Applicants cancelled claim 9. Claims 1-8, 11-30, and 41-58 are presented for examination.

The Examiner rejected claims 1-9, 11-30, and 41-58 under 35 U.S.C. §103(a) as being unpatentable over Smith et al., U.S. Patent No. 5,888,930.¹

Claims 1-8, 11-30, and 41-58 cover particles including a polyvinyl alcohol.

Smith does not explicitly disclose particles including polyvinyl alcohol. Nor does Smith inherently disclose such particles. As stated by the United States Court of Appeals for the Federal Circuit Electro Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994):

The mere fact that a thing *may result* from a given set of circumstances is insufficient to prove anticipation. (citations omitted; emphasis original).

Rather, one asserting that a reference inherently discloses certain subject matter must prove that the features are:

necessarily present [in the prior art reference] and that it would be so recognized by persons of ordinary skill. (Id.)

Here, the Examiner has not satisfied the requisite legal standard because the Examiner has not established that a person of ordinary skill in the art would recognize that Smith necessarily discloses a particle including a polyvinyl alcohol. Rather, the Examiner said:

Smith explicitly states that the polymers “useful for preparation of the beads” of Smith invention includes polyvinyl acetate. See col. 2, line 64. Polyvinyl alcohol is a hydrolyzed product of polyvinyl acetate. Thus, if polyvinyl acetate is used as the starting material for the preparation of the beads taught by Smith, the resulting bead is polyvinyl alcohol. (Office Action at 2.)

¹ Applicants cancelled claim 9, so the rejection of this claim should be withdrawn.

But, the Examiner provided no evidence to support this conclusion. It may be true that under appropriate conditions a vinyl acetate moiety may be hydrolyzed to form a vinyl alcohol moiety. However, as would be recognized by one skilled in the art, the conditions disclosed by Smith would not necessarily result in such hydrolysis. Further, as would also be recognized by one skilled in the art, there is a difference between hydrolyzing a vinyl acetate moiety to a vinyl alcohol moiety, and hydrolyzing a polyvinyl acetate (a polymer containing many vinyl acetate monomers bonded together) could be hydrolyzed to a polyvinyl alcohol (a polymer containing many vinyl alcohol monomers bonded together). Thus, Smith simply does not disclose a particle including a polyvinyl alcohol.

Nor is there any suggestion to modify Smith to provide a particle including a polyvinyl alcohol. Smith discloses numerous different polymers that can be used in his beads. (Smith col. 2, lines 57-65.) He also includes 22 specific examples where he made his beads. (Id. col. 7, line 60-col. 11, line 54.) But, Smith provides no indication polymers beyond those that he disclosed should be used to make his beads. Rather, Smith discloses that his beads satisfy certain needs he identified. (Id. at Abstract and col. 2, lines 14-18.) After reading this, one skilled in the art would not have been motivated to modify Smith's beads to provide the subject matter covered by claims 1-8, 11-30, and 41-58. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 41-46 under 35 U.S.C. §102(b) as being by DE 100 26 620 ("Quelle").² Claims 41-46 cover particles that have an interior region defining pores and a surface region defining pores. Thus, the surface region has pores. Thus, the Examiner's reference to the particles disclosed in claim 3 of Quelle are distinguished by the subject matter covered by claims 41-46. Applicants incorporate herein by reference their arguments regarding Quelle from Applicants' prior Amendment. In view of the foregoing, request reconsideration and withdrawal of this rejection.

Applicants believe the application is in condition for allowance, which action is requested.

² Applicants cancelled claim 9, so the rejection of this claim should be withdrawn.

Applicant : Lanphere et al.
Serial No. : 10/637,130
Filed : August 8, 2003
Page : 11 of 11

Attorney's Docket No.: 01194-465001 / 03-347

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: August 9, 2006



Sean Daley
Reg. No. 40,978

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21332247.doc